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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,425	02/28/2002	William McBride Fesq	602470-002	3201
61834 7590 04/02/2009 Ostrow Kaufman & Frankl LLP Susan Formicola The Chrysler Building 405 Lexington Avenue, 62nd Floor NEW YORK, NY 10174				
EXAMINER LY, ANH				
ART UNIT 2162		PAPER NUMBER		
MAIL DATE 04/02/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/085,425

**Applicant(s)**

FESQ ET AL.

**Examiner**

ANH LY

**Art Unit**

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office action is response to Applicants' Petition filed on 08/01/2008 and RCE filed on 02/11/2008.

***Request for Continued Examination (RCE)***

2. The request filed on 02/11/2008 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/085,425 is acceptable and a RCE has been established. An action on the RCE follows.
3. Claims 1-16 are pending in this Application.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

DeLorme et al. of 5,948,040 (hereinafter DeLorme) teaches searching a particular scheduled events or event of interest database or event calendar database (user-defined event or calendar events) (abstract and col. 27, lines 40-50). DeLorme teaches searching events calendars, the distance value based on the geographical location of route or zip code and selection of location (abstract, col. 7, lines 22-35, col. 17, lines 12-42, col. 19, lines 8-32, col. 20, lines 62-67 and col. 21, lines 1-26; also see col. 47, lines 45-58 and col. 48, lines 5-32).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is "system" claim that is software per se. Because this system can be a web-based information system, a calendar system or information system (see instant specification, page 15 lines 12-15 or page 16, lines 1-2). There is no hardware recitation in the claimed invention. Also, the "data structure", "zip list processor" and "event list generator" are a kind of software modules.

"Software per se" is non-statutory under 35 USC 101 because it is merely a set of instructions without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998).

Claim 9 is "method" claim that is lacking a physical transformation or lacking of being tied to an apparatus, machine or hardware (hardware recitation) in the body of the claims during the process steps. In order to qualify as a 101 statutory process, the claim should positively recite the other statutory class to which it is tied, or positively recite the subject matter that is being physically transformed (see MPEP § 2106.IV.B; and 2106 (IV)(C0(2))((1) & (2) & (a) & (b) & (c)) sections). In the claim 9 has no

hardware recitation in the claim. The term of "data structure" in the body of claim of 9, which does not specify as "hardware" in the claim - software per se. The claim does not readily incorporate positive hardware. Thus, examiner interpreted it (data structure) as a software component.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (Patent No.: US 5,948,040; hereinafter as DELORME) in view of Shaffer et al. (Pub. No.: US 2002/0106069 A1; hereinafter as SHAFFER).

With respect to claim 1, DELORME teaches a system for performing searches across user defined events for an arbitrary geographic region or regions (searching the user-defined geographic area/region event of interest from the TRIPS and calendar and scheduled events database: abstract, col. 8, lines 4-32, col. 9, lines 20-60; col. 19, lines 8-58, col. 20, lines 7-46), the system comprising:

an event data structure comprising one or more user defined events, each event associated with a zip code (TRIPS database is containing travel plan that includes sporting events associated with geographic areas or regions that inherently include zip code for those regions: fig. 1C, col. 8, lines 4-48; col. 24, lines 28-67, col. 25, lines 1-3; col. 28, lines 30-55; col. 41, lines 32-67 and col. 42, lines 1-20);

an event list generator to receive the zip list and query the event data structure to retrieve events associated with zip codes contained in the zip list (TRIPS database includes events information or list based on the geographical areas or region associated with zip code for those areas or region: abstract, col. 33, lines 18-52, col. 41, lines 22-67, col. 51, lines 22-67 and col. 52, lines 1-22).

DELORME teaches searching events from a database containing information of events for a geographical region or regions associated with zip code and calculating the distance of optimum relationships or travel routes between selected geographic places. DELORME does not explicitly teach zip list processor, operative to receive a zip code and a distance value, which are used to calculate a zip list comprising all zip codes geographically located within the distance value from the zip code as claimed.

However, SHAFFER teaches a zip windows file containing a list of all zip codes and distance calculation for distance value based on zip code and latitude and longitude (see fig. 1a, para 0117-0119; also see para 0014 and 0150-0157).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of DELORME with the teachings of SHAFFER. One having ordinary skill in the art would have found it motivated to utilize the use of distance calculation for distance value of a specified geographic region or location disclosed (SHAFFER's para 0117 and fig. 1a), into the system of DELORME for the purpose of providing information about a user location, thereby, enabling a user to find the closest service location and then call forwards the call to the service location (SHAFFER's para 0002, 0007-0009 and 0124).

With respect to claims 2-3, DELORME teaches a system for searching events as discussed in claim 1.

DELORME teaches searching events from a database containing information of events for a geographical region or regions associated with zip code and calculating the distance of optimum relationships or travel routes between selected geographic places. DELORME does not explicitly teach wherein the zip list processor utilizes great circle mathematics to calculate all zip codes geographically located with the distance value from the zip code, and a zip data structure to store one or more zip codes and associated latitude and longitude values as claimed.

However, SHAFFER teaches a zip windows file containing a list of all zip codes and distance calculation for distance value based on zip code and latitude and longitude

and zip array file (see fig. 1a, para 0117-0119; also see para 0014 and 0150-0157 and 0159-0160).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of DELORME with the teachings of SHAFFER. One having ordinary skill in the art would have found it motivated to utilize the use of distance calculation for distance value of a specified geographic region or location disclosed (SHAFFER's para 0117 and fig. 1a), into the system of DELORME for the purpose of providing information about a user location, thereby, enabling a user to find the closest service location and then call forwards the call to the service location (SHAFFER's para 0002 and 0007-0009 and 0124).

With respect to claim 4, DELORME teaches a calendar generator to facilitate creation of a calendars and a calendar data structure (a searchable calendar database: col. 33, lines 20-50, figs. 1C and 6, col. 52, lines 4-67, and col. 53, lines 1-45).

With respect to claim 5, DELORME teaches wherein the each of the one or more user-defined events are associated with a calendar in the calendar data structure (calendar database: col. 33, lines 20-50, figs. 1C and 6, col. 52, lines 4-67, and col. 53, lines 1-45).

With respect to claim 6, DELORME teaches wherein the calendar generator is operative to format and present the calendar and associated user defined events on a display device (col. 25, lines 35-65, col. 27, lines 64-67 and col. 28, lines 1-30).

With respect to claim 7, DELORM teaches wherein the one or more user-defined events are marked as public or private events (TRIPS database contains: Events of



interest or EOs in TRIPS include e.g. personal appointments, public or private scheduled events, predicted natural occurrences, time-limited reservations or offers for goods or services: col. 51, lines 2-22, and col. 58, lines 40-67 and fig. 7).

With respect to claim 8, DELORME teaches wherein private events are excluded from the query performed by the event list generator (col. 51, lines 2-22, and col. 58, lines 40-67 and fig. 7).

Claim 9 is essentially the same as claim 1 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 10 is essentially the same as claim 2 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 11 is essentially the same as claim 3 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 12 is essentially the same as claim 4 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 13 is essentially the same as claim 5 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 14 is essentially the same as claim 6 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 15 is essentially the same as claim 7 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 7 hereinabove.

Claim 16 is essentially the same as claim 8 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 8 hereinabove.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY whose telephone number is (571) 272-4039 or via E-Mail: [ANH.LY@USPTO.GOV](mailto:ANH.LY@USPTO.GOV) (Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (unofficial fax number directly to Examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene** (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to:

**Central Fax Center: (571) 273-8300.**

Anh Ly /AL/  
Examiner, Art Unit 2162  
MAR. 4<sup>th</sup>, 2009

/John Breene/  
Supervisory Patent Examiner, Art Unit 2162